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Paper No. 14

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JUL 07 2004

OFFICE OF PETITIONS

In re Application of :
H. Korn and J. Korn :
Application No. 09/248,436 : ON PETITION
Filed: February 11, 1999 :
Attorney Docket No. P/3253-3

This is a decision on the petition filed March 22, 2004, to revive the above-identified application. The petition will be treated under 37 CFR 1.137(a) and 37 CFR 1.137(b) because petitioner did not indicate under which rule the instant petition is made.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

The petition under 37 CFR 1.137(b) is **DISMISSED**.

The above-identified application became abandoned for failure to file a proper response to the final Office action mailed June 4, 2003, which allowed an extendable period for response of three months from its mailing date. A response was filed on December 8, 2003 (certificate of mailing dated December 4, 2003), along with an extension of time within the third month. The examiner assigned to the application found that the response, though timely, was not compliant. The application became abandoned on December 5, 2003. A Notice of Abandonment was mailed on January 22, 2004.

TREATMENT UNDER 37 CFR 1.137(a)

A grantable petition under 37 CFR 1.137(a)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(1); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due

[1]As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer required by 37 CFR 1.137(c).

The instant petition lacks item (3).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."[3]

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."[4]

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"[5]
"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."[6]

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[7]

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[3]Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency' interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

[4]Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

[5]Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. §706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

[6]Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[8] Nonawarness of a PTO rule will not constitute unavoidable delay.[9]

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances leading to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner essentially the amendment filed December 8, 2003, in response to the final Office action substantially compliant with the applicable rules and placed the application in condition for allowance.

With regard to item (3) above, the aforementioned argument of petitioner in support of petitioner's belief that the above-cited application was unavoidably abandoned is not persuasive. The reason petitioner's argument must necessarily fail is addressed below.

The examiner is the primary authority as to the sufficiency of the arguments made in the amendments filed at this stage in the prosecution of the subject application. In this case, the examiner determined that the amendment filed December 8, 2003, failed to place the application in condition for allowance, and the undersigned does not have the authority to preempt that decision. Relative to how the instant petition is affected by applicant's admitted failure to consistently cancel Claims 54 and 55 throughout the amendment, since the examiner has determined that such failure kept the application from being allowed resulting in the abandonment of the application, it feasible to conclude that the abandonment may have been avoided if petitioner were more careful in the preparation of the amendment. Because reasonable steps could have been take to avoid the abandonment of the application but were not. it cannot be concluded that the abandonment of the application was unavoidable pursuant to 37 CFR 1.137(a). The petition under 37 CFR 1.137(a) is, therefore, dismissed.

TREATMENT UNDER 37 CFR 1.137(b)

The petition under 37 CFR 1.137(b) is also dismissed.

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[7]Id.

[8]See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

[9]See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a non-provisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee, or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy the requirements of items (2) and (3) above.

As to item (2) above, the petition fee was not found with the instant petition papers. The fee of a petition under 37 CFR 1.137(b) is $1,330.00 for a large entity and $665.00 for a small entity. Any renewed petition filed under 37 CFR 1.137(b) must be accompanied by the appropriate petition fee.

As to item (3) above, the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional was not found in the instant petition. This statement, or a statement, that may be construed as such, is necessary in order for the petition to be considered grantable and should be included in any renewed petition filed.

If petitioner wishes to again argue that the reply was largely compliant such that the application should have been allowed and, therefore, not abandoned, petitioner should file a petition to withdraw the holding of abandonment under 37 CFR 1.181 that will be entertained by the an official in the Technology Center that is qualified to address the merits of the sufficiency of an amendment in the prosecution of the application.

The fee of $130.00 paid March 22, 2004, is noted, however; petitioner did not file any petition that has a fee that corresponds to this amount. Accordingly, the fee for the petition under 37 CFR 1.137(a) ($55.00) will be taken from this amount, and the remaining amount refunded to petitioner, in due course.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
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Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

INTEROFFICE MEMO

DATE: May 18, 2004

TO: Jeffrey Harold
Technology Center 2600, GAU 2644

FROM: Kenya A. McLaughlin, 77980 KAM
Petition Attorney
Office of Petitions, CP4-3D10
(703)305-0010

SERIAL NO.: 09/248,436

Please review Paper No. 13 of the above-cited application and determine whether it places the application in condition for allowance. You may indicate your decision below and return the application file to my attention at the location provided above. Thank you.

✓ Yes, the amendment places the application in condition for allowance.

___ No, the amendment does not place the application in condition for allowance.